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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,842	06/13/2002	Giovanni Battista Zenga	DYOUP0227US	2178

7590

06/05/2003

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EXAMINER

ZIMMERMAN, JOHN J

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 06/05/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

AS8

Office Action Summary

Application No. 10/088,842		Applicant(s) ZENGA, GIOVANNI BATTISTA	
Examiner John J. Zimmerman		Art Unit 1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>3,7</u> | 6) <input type="checkbox"/> Other: |

FIRST OFFICE ACTION

Priority

1. The Preliminary Amendment Deleting Multiple Dependencies filed with this application has been entered. Claims 1-15 are pending in this application.

Information Disclosure Statement

2. The Information Disclosure Statement received April 22, 2002 (Paper No. 3) and the Information Disclosure Statement received October 29, 2002 (Paper No. 7) have been considered. Initialed forms PTO-1449 are enclosed with this Office Action.

Specification

3. The disclosure is objected to because of the following informalities: Applicants may wish to insert proper headings in the specification at their appropriate locations (e.g. Related Applications, Field of the Invention, Description of the Prior Art, Summary of the Invention, Brief Description of the Drawings, Description of the Preferred Embodiments, etc. . .).
Appropriate correction is requested.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 1 and 4-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. It is unclear as to what dimensions qualify a hole as a "microhole" (e.g. see independent claim 1, lines 2 and 3). The applicant's disclosure gives no guidance in determining the scope of the term "microhole". It is not clear how small a hole must be in order to meet this limitation. For all that can be determined, the term "microhole" may have limits of tens, hundreds or thousands or more of microns. For purposes of claim interpretation in applying prior art in the ensuing rejections under 35 U.S.C. 102 and 103, the term "microhole" will simply be interpreted as having small holes.

7. In claim 5, it is unclear if relationship of the size of the microholes to the passage of plasma is only an example or a requirement.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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9. Claims 1-5, 9-10 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Donahue (U.S. Patent 2,702,270).

10. Donahue discloses forming fine electroformed mesh screens on a substrate which can have a groove spacing of as high as 2000 lines per inch (e.g. see column 2, lines 46-62; Figures 7, 8). Regarding the intended use of the devices recited in claim 5 and claims 9-10, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In addition, the recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The mere fact that the mesh is metal means that will function as a heat sink to whatever it may be affixed to.

11. Claims 1-2, 4-5, 9-10 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Herrick (U.S. Patent 5,190,653) or McGeary (UK Patent Application GB 2 063 299 A).

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12. Herrick discloses that filters can be electroformed with hole diameters in the range of 12-60 microns (e.g. see column 4, lines 6-19, 50-64; Figures 3, 4). McGeary discloses making very fine electroformed meshes (e.g. see Table on page 2). Regarding the intended use of the devices recited in claim 5 and claims 9-10, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In addition, the recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The mere fact that the sieve is metal means that will function as a heat sink to whatever it may be affixed to. Regarding the issue of whether the meshes of the references would have the same substantially smooth surface as those claimed by the applicant, Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain

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and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

13. Claims 1-5, 9-10 and 14-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Deutsch (U.S. Patent 4,772,540).

14. Deutsch discloses making microsieves and illustrates various forms of these sieves known in the art (e.g. see column 2, lines 5-15; Figures 1B, 1C, 2E). Regarding the intended use of the devices recited in claim 5 and claims 9-10, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In addition, the recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The mere fact that the sieve is metal means that will function as a heat sink to whatever it may be affixed to. Regarding the issue of whether the meshes of the references would have the same substantially smooth surface as those claimed by the applicant, Patent and Trademark Office can require applicants to prove that prior art

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products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

15. Claims 1, 4-5 and 9-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Klemm (U.S. Patent 4,039,397).

16. Klemm discloses electroforming cylindrical screens (e.g. see Figures 1-4; column 4, lines 5-29). Regarding the intended use of the devices recited in claim 5 and claims 9-10, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In addition, the recitation has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190

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USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The mere fact that the sieve is metal means that will function as a heat sink to whatever it may be affixed to.

17. Claims 1 and 5-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamamoto (European Patent Application 0 621 018 A1).

18. Hamamoto discloses forming fine porous laminations for prostheses (e.g. see page 6, lines 42-54; Claim 1; Figures 1-56).

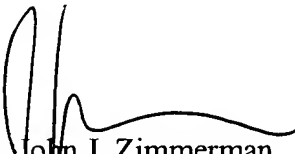
Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 2,226,384 is cited because it shows the typical rounded top of cross sections of electroformed grids (e.g. see Figures 1, 2). U.S. Patent 5,147,852 is of note since it shows electroforming grids with openings down to 5 microns are well known in the prior art (e.g. see column 5, lines 2942). U.S. Patent 6,018,459 is particularly pertinent in that it shows that it is known in the art to use porous metal meshes as heat sinks. Of particular note in the obviousness of using meshes with prostheses - see U.S. Patent 4636219, EP 0038902, EP 0230006. These references establish the level of ordinary skill in the art at the time the invention was made.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (703) 308-2512.

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The examiner can normally be reached on 8:30am-5:00pm, M-F. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



John J. Zimmerman
Primary Examiner
Art Unit 1775

jjz
June 1, 2003